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APPLICATION NO. 09/029,948	FILING DATE 06/09/99	FIRST NAMED INVENTOR DVORKIS	ATTORNEY DOCKET NO. 0291XZB
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MM21/0606  
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489 FIFTH AVENUE  
NEW YORK NY 10017-6105

EXAMINER FRECH, K
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ART UNIT 2876	PAPER NUMBER JH
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DATE MAILED:

06/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



**UNITED STATES DEPARTMENT OF COMMERCE**  
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R.G.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/328,948	06/09/99	DVORKIS	P 0291XZB

MM92/0519  
KIRSCHSTEIN OTTINGER ISRAEL &  
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551 FIFTH AVENUE  
NEW YORK NY 10176-0024

EXAMINER

FRECH, K

ART UNIT	PAPER NUMBER
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2876

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Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/328,948

Applicant(s)

Dvorkis et al

Examiner

Karl D. Frech

Group Art Unit

2876

☒ Responsive to communication(s) filed on 6/9/99, 6/30/99, 8/27/99, 9/13/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 49-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 49-60 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Sep 13, 1999 is ☒ Approved ☐ Disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2876

1. The preliminary amendments filed 6/9/99, 6/30/99, 8/27/99, and 9/13/99 have been entered into the application. By these amendments, claims 1-48 have been canceled and claims 49-60 have been added. The proposed drawing, Figure 13, filed 9/13/99 have been approved by the examiner.

2. Upon review of the parent applications, it has been determined that the currently claimed invention had not been wholly disclosed prior to December 15, 1994, the filing date of the Sakai et al reference relied upon below.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 49-52,54 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 5,859,417 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: all the currently claimed limitations can be found within the patent claims. The examiner

Art Unit: 2876

acknowledges that the patent claims do not specifically state "concave and convex" aplanar mirror surfaces. However, these are inherent features of the "cylindrical and toroidal" lenses of the patent claims. Also, it is acknowledged that the X and Y axis of the current claims are not specifically set forth in the patent claims. However, these too are inherent features of the overall apparatus of the patent claims. That is, these X and Y axis features must be present in the apparatus of the patent claims as they are defined by the patent specification. Therefore, it is in wording and semantics only which the current claims 49-52 and patent claims differ.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 53, 55-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,859,417. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the current claim elements are found with the patent claims except for the laser diode of claim 53 and the first and second aplanar surfaces being convex and concave respectively as in claim 55. However, laser diodes are old and well known in the art. It would have been obvious to a person of ordinary skill in the art to use a laser diode as the laser light source of the patent claims. This would provide a cheap and easily replaceable laser light into the system. Also, both convex and concave mirrors are old and well known. It would have been obvious to a person of ordinary skill

Art Unit: 2876

in the art at the time the invention was made to use a concave surface and a convex surface in the system of the patent claims. The concave and convex alternately shape the scanning light. Thus there would be a greater depth of field of the system of the patent claims.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claim 49 is rejected under 35 U.S.C. 102(e) as being anticipated by Sakai et al 5,572,008.

Sakai discloses a fixed mirror 13 with two aplanar surfaces. These two aplanar surfaces are set on different ellipses focused around the same point, i.e. the two surfaces have different curvatures or profiles. All mirrors by their physical nature "fold" light. As there are no other elements claimed, a "folding mirror" must be taken as just that, a surface capable of "folding" light.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lindacher et al 5,179,271, Lindacher et al 5,484,990, Marom 5,475,208 and Meyers 4,766,298 all disclose multifaceted fold mirrors.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner can normally be reached workdays from 8:30 AM to 3:30 PM.

Art Unit: 2876

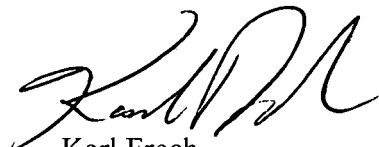
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any fax transmission which may be intended as non-official for consideration by the examiner for interviews or other purposes should be clearly marked "DRAFT" and/or "COURTESY COPY" along with a statement to "DELIVER DIRECTLY TO EXAMINER". Such an un-official fax transmission must not be signed as it **will not** be entered into the application.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

A handwritten signature in black ink, appearing to read 'Karl Frech', with a stylized, flowing script.

Karl Frech

Primary Examiner, AU 2876

May 17, 2000